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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,672

04/21/2006

Makoto Sanpei

14048-029

7213

80711

7590

07/25/2011

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EXAMINER

LENIHAN, JEFFREY S

ART UNIT

PAPER NUMBER

1765

MAIL DATE

DELIVERY MODE

07/25/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/576,672	<b>Applicant(s)</b> SANPEI ET AL.	
	<b>Examiner</b> Jeffrey Lenihan	<b>Art Unit</b> 1765	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 July 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-6 and 9-12.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
 13. ☐ Other: \_\_\_\_\_.

/Irina S Zemel/  
 Primary Examiner, Art Unit 1765

Continuation of 11. does NOT place the application in condition for allowance because:

Regarding the submitted declaration of Makoto Sanpei: The submitted declaration has not been signed and dated by inventor Makoto Sanpei; applicant concedes that the declaration is unexecuted in the submitted remarks (page 10, lines 7-12). The unsigned document therefore does not provide the assurances that any statements or representations made within it are correct, as provided by 35 USC 25 and 18 USC 1001 (see MPEP 716.02(g)). The declaration therefore cannot be relied upon to overcome the rejection of claims under 35 USC 103(a).

Regarding the criticality of the lower limit of 400: Applicant argues that 1) it is applicant's prerogative to claim less than the invention their disclosure supports, and 2) the comparison of an example using an oligomer having Mn of 443 demonstrates the criticality of the claimed lower limit of 400 versus the lower limit of 100 disclosed in Yang. This is not persuasive.

Applicant can rebut a presumption of obviousness based on a claimed invention that falls within a prior art range by showing that there are new and unexpected results relative to the prior art, see *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1322, 73 USPQ2d 1225, 1228 (Fed. Cir. 2004). The applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range; see *In re Woodruff*, 919 F.2d 1575, 16, USPQ2d 1934 (Fed. Cir. 1990). To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range; see *In re Hill*, 284 F.2d 955, 128, USPQ 197 (CCPA 1960). As noted in the cited case law, evidence of unexpected results is required to demonstrate the criticality of the claimed range, not the range disclosed in the specification. As noted in paragraph 8 of the previous Office Action, applicant's arguments submitted on 1/31/2011 that the critical lower limit is 300 is in direct opposition to the assertion that the claimed lower limit of 400 is critical to achieve the allegedly unexpected results.

Regarding the allegedly unexpected results discussed in the declaration: The allegedly unexpected results due to the use of an oligomer having molecular weight of 443 would not be sufficient to demonstrate the criticality of the claimed range per the reasons outlined in the previous Office Action with regards to the claimed lower limit of 400. Applicant further argues that the claimed upper limit of 1000 is not even close to the upper limit of 10000 which Yang discloses; this is not persuasive. In the case where the claimed ranges overlap or lie inside ranges disclosed in the prior art, a prima facie case of obviousness exists; see *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (MPEP § 2144.05). The claimed range of 400 to 1000 is inside the molecular weight range disclosed by Yang; barring a showing of unexpected results, it therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to use an oligomer having a molecular weight of 1000 as a plasticizer, in view of the teachings of Yang.